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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,874	04/06/1999	FRANK L. GRAHAM	ADVEC9	5534

7590 12/03/2001  
GERARD H BENCEN  
426 ANDERSON COURT  
ORLANDO, FL 32801

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 12/03/2001

13

Please find below and/or attached an Office communication concerning this application or proceeding.

File

**Advisory Action**Application No.  
09/286,874Applicant(s)  
Grahm, F. et al.Examiner  
Joseph T. WoitachArt Unit  
1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Nov 19, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**THE PERIOD FOR REPLY** [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached.

4. ☐ Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
Applicants' arguments are directed to claims which have not been entered.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: 8 and 9  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1-4 and 13-15
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☐ Other: \_\_\_\_\_

*Deborah Crouch*  
**DEBORAH CROUCH**  
**PRIMARY EXAMINER**  
**GROUP 1800/1630**

Art Unit: 1632

Please note that the Examiner of record and art unit has changed. The Examiner of record is now **Joseph T. Voitach** and the group art unit is now **1632**.

3(a) NOTE:

The amendment of -adenovirion- from 'adenoviral' raises 35 USC 112, first paragraph issues. In light of Applicants' statements regarding the proposed amendment, it appears that Applicants' wish to delete only proteins which encode coat proteins (see Applicants' after final amendment, bottom of page 5), however the artisan would consider a virion as the whole viral particle, and as such, would encompass any protein found in said viral particle. In addition, Examiner cannot find support in the instant specification for the use of term 'adenovirion' in which would be consistent with applicants' arguments. While the proposed amendment does not change the scope of the claim, it raises new issues regarding specific support in the instant specification and thus, issues regarding the limitation(s) of the claim.

With regard to the proposed amendment deleting 'but which helper....viral particles', Examiner would agree that the phrase does not describe a novelty of the invention (see Applicants' after final amendment, middle of page 7), however, the deletion of this limitation would broaden the scope of the claim. Absent any limitation on the helper virus, it would include the use of any adenovirus even it is packaged into a viral particle, and thus would require a new search and further consideration. Applicants' proposed claim amendments do not remedy

Art Unit: 1632

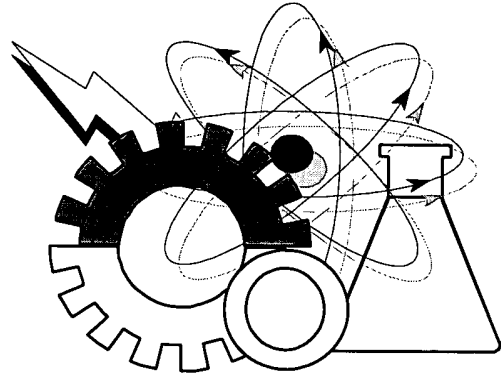
the rejections of record, and would necessitate a new search and further consideration, therefore, the amendments have not been entered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach, whose telephone number is (703) 305-3732.

If attempts to reach the examine by telephone are unsuccessful, the examiner's supervisor, Karen M. Hauda, can be reached on (703) 305-6608.

An inquiry of a general nature or relating to the status of the application should be directed to Kay Pinkney whose telephone number is (703) 305-3553.

Joseph Woitach  
Patent Examiner (US-PTO)  
Phone: 703-305-3732  
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# Fax

**To:** Joesph Fischer

**Fax:** (407) 228-0329

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**Phone:** (407) 228-0328

**Date:** December 17, 2001

**Re:** copy of Advisory action for 9/286,874

☒ **Urgent**    ☒ **For Review**    ☐ **Please Comment**    ☐ **Please Reply**    ☐ **Please Recycle**

● **Comments:**

Attached is a copy of the Advisory Action which was mailed December 3, 2001. It appears that the mailing address for this application in our system may not be current. The mailing address on the office action is 426 Anderson Court, and the address on the last mailing from your office is from 1630 Hillcrest Street.

Please contact me if you need any more information.

Sincerely,

Joseph T. Woitach